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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,335	04/12/2004	Steven H. Balanchi	1342	3148

7590 05/24/2005

FREDERICK GOTHA, ESQ.
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EXAMINER

FRANCIS, FAYE

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/822,335

Applicant(s)

BALANCHI, STEVEN H.

Examiner

Faye Francis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 2-4 and 11-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,5-10 and 15-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Applicant's election with traverse of group II in the reply filed on 4/20/05 is acknowledged. The traversal is on the ground(s) that claims 2, 3, and 4 are a species of claim 1, and that claims 11, 12, 13, and 14 are a species of claim 10. This is not found persuasive because according to the MPEP when there is an allowable claim, dependent claim should not be restricted. As no allowable claims have been indicated such constraints do not apply to the case.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 5-6, 8, 10, 15-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Yonkers [2,979,388].

Yonkers discloses in the embodiment of Fig 4, an adjustable length connecting member [magnetic bar 40] for magnetically coupling with a magnetizable body in a magnetic construction toy comprising: (a) a first member [the lower sheath 41 and screw 44] having a distal end, a proximate end, and a longitudinal axis [Fig 4]; (b) a first magnet 43 captively carried by the first member adjacent the distal end; (c) a second member [the upper sheath 41] having a first end, a second end, and an axis of elongation co-linear with the horizontal axis where the first member is so mounted in telescopic

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relationship with the second member to permit relative bi-axial displacement of the first member with respect to the second member; (d) a second magnet 43 captively carried by the second member adjacent the second end; and (e) adjustment means [threads] associated with the first member and the second member responsive to external force for selectively adjusting the axial distance between the distal end and the second end to a pre-determined axial length [col 5 lines 7-14]. Additionally, Yonkers discloses the adjustment means comprises: (a) external threads [threads on the screw 44] extending at least in part axially between the distal and proximate ends of the first member. (b) internal threads [threads inside the upper sheath 41] extending at least in part axially between the first and second ends of the second member for engagement with the external threads to permit axial translation of the first member with respect to the member [col 5 lines 7-14] and the first and second members are cylindrically shaped.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7, 9, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonkers.

Yonkers discloses most of the elements of these claims but for the first and second members are conically tapered adjacent the distal end and the second end respectively.

Yonkers does not disclose a conically tapered shaped the first and second members. However, Yonkers discloses that the ends of the bar are ground to form a concave surface conforming to the surface of the sphere. Applicant has not disclosed that having the first and second members at this specific shape solves any stated problem or is for any particular purpose. Moreover, it appears that the device of Yonkers, or applicant's invention, would perform equally well with the first and second members having any particular shape as long as the ends of the bar are ground to form a concave surface conforming to the surface of the sphere in order to provide for flush seating and magnetic engagement of the sphere with the bar.

Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified Yonkers such that the first and second members have conically tapered shape because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Yonkers.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 571-272-4423. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FF



Faye Francis